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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,894	09/12/2003	David F. Tobias	H052404.0100US0	8525

1200 7590 09/27/2004

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HOUSTON, TX 77002

EXAMINER

SHIN, CHRISTOPHER B

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/661,894

Applicant(s)

TOBIAS ET AL.

Examiner

Christopher B Shin

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09122003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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### DETAILED ACTION

1. The IDS filed September 12, 2003 seems to have missing references that was cited in the parent case. Please check the 09/209,190 application and complete the PTO-1449 in response to this office action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a. Claims 1-3, 6, 8 & 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobson et al. (5,694,399).

i. In figures 1-2 & 4-6 and its respective description sections teaches all of the basic claimed limitation as follows:

#### Claims 1-3, 6 8, 10

#### Jacobson et al. (1-2 & 4-6)

- execution unit
  - feature of (112, 210)
- peripheral device coupled to the execution unit, peripheral device comprising configuration registers
  - feature of Device (300) coupled to (112, 210)
- means for defining a scan path comprising the configuration registers and for communicating configuration data for the peripheral device
  - feature of figure 3, (420, 200, 430) & (112,210)
- means for saving/loading the configuration data via the scan path
  - feature of (220,540,550,560), see also column 9, lines 11-15

- command to load/save detection
  - feature of (200,210)

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- ii. Since the Jacobson reference teaches all of the basic claimed limitations, the claimed invention is anticipated by the teachings of the Jacobson.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-5, 7, 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (5,694,399).

- iii. The teachings of the parent claims 3 & 8 are similarly applied in this rejection.
- iv. As for claims 4-5 & 9, further add limitations regarding a specific modes of operation for saving/loading step prior power saving and periodically. This is not expressly taught by the Jacobson reference. However, the above difference/added limitations are common knowledge in the art for their well-known benefit of saving power and state for the better reliability of the system. The above-added function/option is commonly practiced in the art, but not necessary function of the Jacobson system or the claimed system. In other words, one skilled in the art can simply not include such features to save design and manufacturing cost. If reliability is important, one skilled artisan can easily choose to add such function/option at a higher cost. Examiner takes official notice on such well-known optional function/option. Therefore, it would have obvious at

the time the invention was made to One skill in the art can easily choose to add or not add such optional function/option for the reasons stated above to come up with the claimed invention form the teachings of the Jacobson reference.

v. As for claims 7 & 11, a similar rational is also applied for using or substituting different types of memory used (i.e., ROM), see above paragraph for the similar details.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>©</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

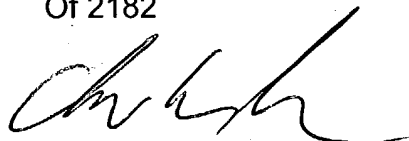
5. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3 & 5 of U.S. Patent No. 6,363,501. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Tobias reference (501) teaches substantially identical invention/invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B Shin whose telephone number is 703-305-9658. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Shin  
Primary Examiner  
Of 2182



September 17, 2004  
CBS